

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed : October 24, 2003
Page : 3

39. (Previously Cancelled) The method of claim 35 or 38, wherein the microtubule-destabilizing agent is a taxol or taxol-like compound.

40. (Cancelled)

41. (New) The method of claim 35, wherein the microtubule-destabilizing agent is a taxol or taxol-like compound.

42. (New) The method of claim 38, wherein the microtubule-destabilizing agent is a taxol or taxol-like compound.

REMARKS

Claims 1-3, 6-8, 18-21, 27-29, 31-38 and 40 are pending in this application.

Applicant would like to note that a Preliminary Amendment was filed on October 24, 2003, attached hereto as Exhibit A (3 pages) and Exhibit B (1 page) a copy of a postcard which was indicated by the USPTO the date received as October 24, 2003. Accordingly, claims 1-40 are not pending but claims 1-3, 6-8, 18-21, 27-29, 31-38 and 40 are pending under examination.

Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that the following inventions or groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner stated that the Applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Under 35 U.S.C. § 121 and 372, restriction to one of the following groups of inventions is required:

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed : October 24, 2003
Page : 4

- I. Group I, claim(s) 1-5, 9-16, and 22, drawn to a method for screening, quantitating, and identifying a mixture of compounds for activity, classified in class 435, subclass 41.
- II. Group II, claim(s) 6, 8-15, 22, and 30 drawn to a method of screening a mixture of compounds and identifying the active metabolite, classified in class 435, subclass 4.
- III. Group III, claims(s), 7, 9-15, 22 and 30 drawn to a method of quantitating an herbal extract, classified in class 435, subclass 4.
- IV. Group IV, claim(s), 18-20 drawn to a method of producing a fingerprint of an extract of a natural product, classified in class 435, subclass 41.
- V. Group V, claim(s), 21 and 30, drawn to a method of producing a fingerprint of an extract of a natural product, classified in class 424, subclass 9.2.
- VI. Group VI, claim(s) 23, drawn to the fingerprint produced by V or VI, classified in class 424, subclass 9.2.
- VII. Group VII, claim(s) 24, drawn to a method to determine batch-to-batch variation of an extract, classified in class 435, subclass 174.
- VIII. Group VII, claim(s) 25, drawn to a method to assay for formulation variation of an extract, classified in class 436, subclass 8.
- IX. Group IX, claim(s) 26, drawn to a method to assay for dose variation of an extract, classified in class 436, subclass 8.

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed : October 24, 2003
Page : 5

- X. Group X, claim(s) 27, 28 and 30, drawn to a method for identification of induced compounds in a subject, classified in class 424, subclass 9.1.
- XI. Group XI, claim(s) 29, drawn to the induced compounds identified by XI, classified in class 424, subclass 9.1.
- XII. Group XII, claim(s) 31 and 32 drawn to a method for treating cancer in a subject, classified in class 435, subclass 7.23.
- XIII. Group XIII, claim(s), 33-39 drawn to a method for treating cancer in a subject, classified in class 435, subclass 7.23.
- XIV. Group XIV, claim(s) 40, drawn to an anti-tumor composition, classified in class 435, subclass 4.

In response, Applicant respectfully traverses the above restriction.

Under MPEP, there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the Examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes independent claims or distinct inventions.

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed : October 24, 2003
Page : 6

Applicant maintains that the above described Groups are NOT independent. The claimed invention related to Huanglian (Claims 31-40; Group XII-XIV) leads to the invention of Claims 1-30 (Group I-IX). Therefore, the Groups are dependent.

Applicant further submits that claims 1-40, Groups I-XIV, do not require restriction as they are connected by a single, searchable unifying relationship that connects the claims (MPEP § 802.01). Therefore, Applicant maintains that the Examiner would not be seriously burdened by searching and examining all of the pending claims in a single application.

A search for the Huanglian composition, and different uses of said composition (Group XII) will reveal prior art in connection with the method to make and use of said composition and for herbal extract as a whole (Group I-XI and XII to XIV). Given the single, searchable unifying relationship, the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application. (See MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02. Accordingly Applicant requests withdrawal of the restriction of claims 1-40.

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicant hereby elects Group XII, drawn to a method for treating cancer in a subject and requests the entry of the above amendment.

Claim 33 is amended to depend on claim 31. New claims 41 and 42 correspond to the cancelled claim 39. Accordingly, there is no issue of new matters and Applicant respectfully requests the entry of this Amendment.

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
Filed : October 24, 2003
Page : 7

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Response. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

I hereby certify that this paper is being facsimile transmitted to:	
Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 Fax No.: (571) 273-8300	
on the date shown below.	
<u>Albert Wai Kit Chan</u>	<u>9/29/05</u>
Albert Wai-Kit Chan	Date
Reg. No. 36,479	

Respectfully submitted,
Albert Wai Kit Chan
Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicant
Law Offices of
Albert Wai-Kit Chan, LLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 799-1000
Fax: (718) 357-8615
Email: chank@kitchanlaw.com